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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,707	07/12/2001	Guy Nathan	871-103	1529
23117	7590	12/15/2005		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER MA, JOHNNY	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/902,707	NATHAN ET AL.	
	Examiner	Art Unit	
	Johnny Ma	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/01; 8/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/817528 (US 6,308,204 B1), filed on 08/05/1997.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 6-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,308,204 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

- a. Considering claim 6, claim 6 in the Instant Application corresponds to claim 1 in Patent #6,308,204 B1 ("Patent '204").

The claimed "providing a jukebox device including a microprocessor, a memory that stores audiovisual items that may be played on the jukebox device in response to

requests by a user, a display for displaying video, an audio arrangement providing audio, a communication system for enabling the jukebox device to communicate with an audiovisual distribution network, and a multitasking operating system that enables simultaneous operation of the microprocessor, the display, the audio arrangement and the communication system” of the Instant Application equates to and is the same as “a jukebox device including a microprocessor, a memory that stores audiovisual items that may be played on the jukebox device in response to requests by a user, a display for displaying video, an audio arrangement providing audio, a communication system for enabling the jukebox device to communicating with an audiovisual distribution network, and a multitasking operating system that enables simultaneous operation the microprocessor, the display, the audio arrangement and the communication system” in Patent ‘204.

The claimed “and further wherein said jukebox device includes operating software that controls operation of said jukebox” of the Instant Application equates to and is the same as “wherein said jukebox device includes operating software that controls the operation of said jukebox” in Patent ‘204.

The claimed “providing a server remote to said jukebox device that can be accessed by said jukebox device through said distribution network” of the Instant Application equates to and is the same as “a server remote to said jukebox device that can be accessed by said jukebox device through said distribution network” in Patent ‘204.

Claim 6 in the Instant Application recites “downloading audiovisual items from the server to the jukebox device and storing the downloaded audiovisual items on the

jukebox device,” which is not recited in Patent ‘024. It would have been obvious to modify Patent ‘024 to include “downloading audiovisual items from the server to the jukebox device and storing the downloaded audiovisual items on the jukebox device” for the benefit of allowing remote updating of media available to users of the device.

Furthermore, claim 6 in the Instant Application also recites “uploading royalty information from the jukebox device to the server for use in accounting for music rights associated with the audiovisual items,” which is not recited in Patent ‘024. I would have been obvious to modify Patent ‘024 to include “uploading royalty information from the jukebox device to the server for use in accounting for music rights associated with the audiovisual items” for the benefit of allowing the provider to remotely access usage statistics so that the provider may determine royalty payment owed without requiring personnel visit each device and manually acquire the usage information.

Patent Application ‘204 recites “wherein said server is operable to register said jukebox for operation through communication with the jukebox device” which is not recited in the instant claim. However, the Instant Application recites “registering said jukebox device for operation through communication between the jukebox device and the server.” It would have been obvious to broaden claim 1 to get claim 6 by not including “said server is operable to register.”

Patent Application ‘204 recites “and said server is operable to send data to said jukebox device which is interpreted by said jukebox as a request by said server to remotely update said operating software on said jukebox which is not recited in the instant claim. However, the Instant Application recites “sending update data from said

server to said jukebox device which is used by said jukebox device to remotely update said operating software on said jukebox device.” It would have been obvious to broaden claim 1 to get claim 6 by not including “which is interpreted by said jukebox as a request by said server.”

Patent Application ‘204 recites “upon receipt by said jukebox of said data from said server indicating a request to remotely update said operating software, said jukebox device is operable to modify start-up operation of said jukebox device such that said jukebox device will operate in accordance with new operating software received from said server over said distribution network” which is not recited in the instant claim.

However, the Instant Application recites “and upon receipt by said jukebox device of said update data, modifying said jukebox device such that said jukebox device will operate in accordance with new operating software received from said server over said distribution network.” It would have been obvious to broaden claim 1 to get claim 6 by not including “from said server indicating a request to remotely update said operating software” and “start-up.”

b. Considering claim 7, claim 7 in the Instant Application corresponds to claim 2 in Patent ‘204.

The claimed “further including, upon receipt of said update data, verifying by said jukebox device if a version number of current software is outdated” of the Instant Application equates to and is the same as “wherein upon receipt of said data, said jukebox is operable to verify if a version number of current software is outdated” in Patent ‘204.

The claimed “and, if said version number is outdated, performing a back up of the current operating software, modifying a system startup file for startup with the back up of the current software, beginning execution of a new version of said software received from said server, verifying proper operation of said new version of said software” of the Instant Application equates to and is the same as “and further wherein, if said version number is outdated, said jukebox performs a back up of current operating software, modifies a system startup file for startup with the back up of the current software, begins execution of the new version of said software, verifies proper operation of said new version of said software” in Patent ‘204.

The claimed “and, if said new version properly operates, reinitializing the system startup file for startup with the new version” of the Instant Application equates to and is the same as “and, if said new version properly operates, reinitializes the system startup file for startup with the new version.

c. Considering claim 8, claim 8 in the Instant Application corresponds to claim 3 in Patent ‘204.

The claimed “further including, if said verification of said new version indicates an error, reinitializing said current version of said software, and sending an error message to said server” of the Instant Application equates to and is the same as “wherein if said verification of said new version indicates an error, said jukebox device is operable to reinitialize said current version of said software, and to send an error message to said server” in Patent ‘204.

Art Unit: 2617

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US 5,355,302) in further view of Hendricks et al. (US 6,408,437 B1).

As to claim 6, note the Martin et al. reference that discloses a system for managing a plurality of computer jukeboxes.

The claimed “providing a jukebox device including a microprocessor, a memory that stores audiovisual items” is met by microprocessor 121A (Martin 5:27) and “songs and displays graphics...are stored locally in the large-volume data storage unit 93” (Martin 5:8-10).

The claimed “that may be played on the jukebox device in response to requests by a user” is met by “once a specific song has been selected and queued-up, the processing circuit 121 first identifies the beginning address of the compressed digital data from the song address field 37 of the song record 29 in the queue. From this address, using the bus 124, the circuit 121 reads the compressed digital data out of the storage unit 93, decompressed that data, and sends the decompressed digital data to the audio reproduction circuit 127” (Martin 7:56-64).

Note the Martin et al. reference discloses a visual display 125 (Martin 5:45) for displaying graphics accompanying played songs (Martin 5:8-10). However, the Martin et al. reference does not specifically disclose “a display for displaying video.” Nevertheless, the examiner gives Official Notice that it is notoriously well known in the presentation of music to accompany the music with video, such as music videos, for the purpose of providing a more engaging and

pleasing presentation to the users of the presentation device. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the Martin et al. visual display for graphics accordingly for the above stated advantages.

The claimed “an audio arrangement providing audio” is met by audio reproduction circuit 127 coupled to a speaker system 129 (Martin 5:56-59).

The claimed “a communication system for enabling the jukebox device to communicate with an audiovisual distribution network” is met by modem 19 and audiovisual distribution network 15 as illustrated in Figure 1 (see Martin).

The claimed “and a multitasking operating system that enables simultaneous operation of the microprocessor, the display, the audio arrangement and the communication system” is met by “[t]he jukebox 13 also includes a processing circuit 121 which contains a microprocessor 121A, read only memory (ROM) 121B and random access memory (RAM) 121C. As in conventional computer systems, the microprocessor 121A operates in accordance with the software program...processing circuit 121 controls the operation and flow of data into and out of the jukebox 13 through the modem 19 [communication system]...controls a visual display 125 [display]...further controls, via the bus 124, an audio reproduction circuit 127 coupled to a speaker system 129” (Martin 5:26-59).

The claimed “and further wherein said jukebox device includes operating software that control operation of said jukebox” is met by “the microprocessor 121A operates in accordance with the software program” (Martin 5:29-31).

Art Unit: 2617

The claimed “providing a server remote to said jukebox device that can be accessed by said jukebox device through said distribution network” is met by “[t]he central management system 11 communicates with each computer jukebox 13 via transmission link 15” (Martin 3:26-28).

The claimed “registering said jukebox device for operation through communication between the jukebox device and the server” is met by “[t]he central management system 11 communicates with each computer jukebox 13 via a transmission link 15” (Martin 3:26-28) and “the central management system 11 monitors each jukebox 13 to determine the number of times each song has been played” (Martin 3:7-12) wherein it is inherent that the jukebox device be registered with the central management system [server] in order for the server to successfully communicate with each particular jukebox computer.

The claimed “downloading audiovisual items from the server to the jukebox device and storing the downloaded audiovisual items on the jukebox device” is met by the management system 11 downloads to the jukebox songs and graphics (Martin 6:19-58).

The claimed “uploading royalty information from the jukebox device to the server for use in accounting for music rights associated with the audiovisual items” is met by “[p]articularly, the central management system 11 monitors each jukebox 13 to determine the number of times each song has been played. From these numbers, the central management system 11 can calculate the royalty payments that are due” (Martin 3:7-12).

Note, the Martin et al. reference discloses jukebox software (Martin 5:26-33) and updating songs on the jukebox (Martin 6:8-58). However, the Martin et al. reference is silent as to upgrading the jukebox software. Now note the Hendricks et al. reference that discloses a reprogrammable terminal.

Art Unit: 2617

The claimed “sending update data from said server to said [...] device which is used by said [...] device to remotely update said operating software on said [...] device” is met by the transmitting of update data from the network controller [server] to the device for remote reprogramming (Hendricks 28:14-20).

The claimed “and upon receipt by said [...] device of said update data, modifying said [...] device such that said [...] device will operate in accordance with new operating software received from said server over said distribution network” is met by “[u]pon completion of loading of the new executable 1106 into FLASH ROM 1108, the microprocessor 602 will command that the set top terminal 220 be reset. Resetting the set top terminal 220...causing the new executable program version n+1 1106 to be run” (Hendricks 28:40-45). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Martin et al. jukebox software and central management system with the Hendricks remote updating of a device from a server for the purpose of providing a convenient way of upgrading functionality of the jukebox without requiring service personnel to visit each physical location and manually upgrade the software.

The claimed “sending update data from said server to said jukebox device which is used by said jukebox device to remotely update said operating software on said jukebox device” and “and upon receipt by said jukebox device of said update data, modifying said jukebox device such that said jukebox device will operate in accordance with new operating software received from said server over said distribution network” are met by the Martin et al. and Hendricks et al. combination as discussed above.

6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US 5,355,302) in further view of Hendricks et al. (US 6,408,437 B1), Bacon et al. (US 5,440,632), Beaverton (US 5,210,854), and Nilsson et al. (US 5,410,703).

As to claim 7, the claimed “further including, upon receipt of said update data, verifying by said jukebox device if a version number of current software is outdated, and, if said version number is outdated.” Note the Martin et al. and Hendricks et al. combination teaches the updating of jukebox software as discussed in the rejection of claim 6. However, the Martin et al. and Hendricks et al. combination does not specifically teach a version comparison. Now note the Bacon et al. reference that discloses a reprogrammable subscriber terminal. The claimed “further including, upon receipt of said update data, verifying by said [...] device if a version number of current software is outdated, and, if said version number is outdated...” is met by “[i]f the code revisions match, that means that the code revision that the parameters transaction is attempting to download is already in the memory space of the control microprocessor 128. Therefore, the program exits. If, on the other hand, the code revisions do not match then the control processor 128 will...” (Bacon 15:27-68). Note the Martin et al., Hendricks et al., and Bacon et al. combination teaches comparing version information as discussed above and performing a function if the version number is outdated. Further note, the Hendricks et al. reference discloses an embodiment wherein the current program version remains in FLASH ROM while the new program version is installed (Hendricks 28:1-13) and “[i]f a single FLASH ROM does not have enough memory capacity to store both the current program version n 1110 and a new program version, the new program version 1106 can be loaded into a second FLASH ROM” (Hendricks 28:36-39). Also note, the Martin et al. reference discloses a ROM for the

Art Unit: 2617

software and RAM for a scratch pad (Martin 5:26-32). However, the Martin et al., Hendricks et al., and Bacon et al. combination does not specifically teach “performing a back up of the current operating software.” Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to back up current software prior to the installation of a newer version of the software for the purpose of keeping the original working software available for roll-back in the event the new software fails to install or operate properly. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Martin et al., Hendricks et al., and Bacon et al. combination accordingly for the above stated advantages. In view of Hendricks et al. recognition that the first FLASH ROM may not have sufficient space to store both versions and the Martin et al. teaching of using a ROM for software and RAM as a scratchpad, the combination as discussed above teaches backing up the current software onto RAM (scratchpad) and installing the new software in ROM (software memory) satisfying the claimed “performing a back up of the current operating software.”

Further note, Hendricks et al. discloses, generally, switching between the two versions of software (Hendricks 28:40-45). However, the combination as discussed does not specifically disclose a startup file. Now note the Beaverton et al. reference that discloses a system for updating program stored in EEPROM by storing new version into new location and maintaining a transfer vector to contain the starting address of the old version or new version (Beaverton 3:10-25). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Martin et al., Hendricks et al., and Bacon et al. combination with the Beaverton et al. startup file initially pointing at the current software and modifying the startup file to point to the new version of software upon completed

Art Unit: 2617

loading for the purpose of providing a method for recovering from an installation error of the new version of software. The claimed “modifying a system startup file for startup with the back up of the current software” is met by the Martin et al., Hendricks et al., Bacon et al., and Beaverton et al. combination as discussed above wherein in order to point to the current program, it is inherent that the start up file be modified to point to the back up of the current software. Note, the Martin et al., Hendricks et al., Bacon et al., and Beaverton et al. combination discloses “and, if said new version properly [loads], reinitializing the system start up file for startup with the new version” (Beaverton 3:20-25). However, the Martin et al., Hendricks et al., Bacon et al., and Beaverton et al. combination fails to specifically teach the method being triggered by the execution of the new version of software. Now note the Nilsson et al. reference that discloses executing the software and if there is a problem rollback to the old version of software (Nilsson 11:15-68; 12:12-37). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Martin et al., Hendricks et al., Bacon et al., and Beaverton et al. combination teaching modifying a startup file if the new version is properly loaded with the Nilsson et al. execution error for the purpose of ensuring that the software executes properly prior to the transfer of control from the old version of software to the new version of software. The claimed “beginning execution of a new version of said software and, if said new version properly operates, reinitializing the system start up file for startup with the new version” is met by the Martin et al., Hendricks et al., Bacon et al., Beaverton et al., and Nilsson et al. combination as discussed above.

As to claim 8, the claimed “further including, if said verification of said new version indicates an error, reinitializing said current version of said software” is met by that discussed in the rejection of claim 7. The claimed “and sending an error message to said server” is met by the transmission of a message to the server upon failure of the installation (Hendricks 27:65-67).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Kirouac et al. reference (US 5,155,847) discloses a method and apparatus for updating software at remote locations.

The Gross et al. reference (US 6,430,738 B1) discloses a method and system for reversible installation of software applications in a data processing system utilizing an automated archival process.

The Halladay reference (US 5,713,024) discloses a cold boot data backup system.

The Mathur reference (US 5,008,814) discloses a method and apparatus for updating system software for a plurality of data processing units in a communication network.

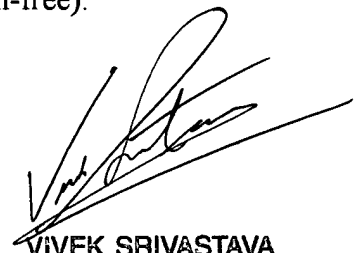
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm



VIVEK SRIVASTAVA
PRIMARY EXAMINER